

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) :	Michael D. SENGER	Group Art Unit: 2621
Appln. No. :	10/603,868	Examiner: David J. Czekaj
Filed :	June 26, 2003	Confirmation No.: 1430
For :	SYSTEM AND METHOD FOR EFFICIENTLY USING VIDEO ENCODING RESOURCES	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Window, Mail Stop **AF**  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

This request is being filed concurrently with a Notice of Appeal and in response to the Final Office Action dated January 4, 2008 ("Final Office Action"). Reconsideration and withdrawal of the rejections, and allowance of the claims are respectfully requested in view of the following remarks.

**Remarks**

In the Office Action, claims 1-4, 10, and 14-19 are rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent No. 6,917,009 issued to Rosenbaum et al. ("Rosenbaum"). Claims 5 and 20 are rejected under 35 U.S.C. §103(a) for being unpatentable over Rosenbaum in view of U.S. Patent No. 5,043,908 issued to Manduley et al. ("Manduley"). These rejections are respectfully traversed.

**Independent Claims 1, 10, and 15**

Independent claims 1, 10, and 15 recite, in pertinent part:

*... determining whether an estimated time for video coding exceeds a determined threshold, if an imaging device does not resolve information needed for handling an article ...*

The Examiner acknowledges that Rosenbaum does not disclose this feature. However, the Examiner contends, "Rosenbaum does disclose processing mail at a rate of 10 pieces per

second” and “in order to keep the system processing at a rate of 10 pieces per second, a time comparison with a threshold must be present ...” (Final Office Action, pages 3-4). The Examiner concludes that “it would have been obvious ... to implement the time comparison with a threshold in order to prevent the system from creating a huge backlog of uncoded mail pieces” (FOA, page 4). Applicants respectfully disagree, and submit that Rosenbaum does not render the claimed invention obvious.

Applicants incorporate by reference the arguments set forth at pages 7-14 of the Response filed October 5, 2007. According to those arguments, Applicants submit that: (i) it does not necessarily flow from the teachings of Rosenbaum that Rosenbaum’s system performs the step of *determining whether an estimated time for video coding exceeds a determined threshold*; and (ii) it would not have been obvious to modify Rosenbaum to include the step at issue since such a modification would render Rosenbaum’s system unsatisfactory for its intended purpose and/or would change the principle of operation of Rosenbaum’s invention.

As the Examiner correctly notes, Rosenbaum does not explicitly disclose or teach *determining whether an estimated time for video coding exceeds a determined threshold*, as recited in the claimed invention. In fact, Rosenbaum makes no mention of an estimated time for video coding or a threshold, much less of a making a determination based upon a comparison between the two. Instead, Rosenbaum teaches that an unsuccessfully read mail piece is placed into a delay loop or taken offline while its image is sent to the video coding stations for manual processing by a clerk. Rosenberg is silent as to estimating a time to perform the video coding, or to determining whether such an estimated time exceeds a threshold.

Contrary to the Examiner’s assertions, it does not necessarily flow from the teachings of Rosenbaum that “in order to keep [Rosenbaum’s] system processing mail at a rate of 10 pieces per second, a time comparison with a threshold must be present.” This assertion is mere speculation based upon the possible operation of Rosenbaum, is unsupported by the factual evidence, and is insufficient to establish a *prima facie* case of obviousness.

Rosenbaum discloses that the feeder 110 feeds mail pieces to the video scanner 120 at a rate of approximately 10 mail pieces per second. In other words, the “10 mail pieces per second” is a feeding rate of the scanner 120. However, there is no indication that the rate of the scanner 120 is affected by the downstream happenings of the system. This is because mail pieces that leave the scanner are either sorted into a bin (step 314) or placed in holding (step 322). The mail

pieces placed into holding 322 are placed into a delay loop or taken offline (col. 6, lines 40-43). Thus, the holding 322 acts as a buffer that insulates the scanner 120 from the remainder of the system. For example, depending on the capacity of the delay loop and/or the number of items taken offline, the scanner could continue to operate at 10 pieces per second without any need for ever determining an estimated time for video encoding. Therefore, the Examiner's assertion that a "comparison with a threshold must be present" is flawed.

Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Office may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. *See, In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The Court of Appeals for the Federal Circuit has repeatedly cautioned against employing hindsight by using a patent applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). In this case, the Examiner is resorting to speculation and hindsight reconstruction to supply the admitted deficiencies of Rosenbaum. That is, the Examiner is using Applicants' disclosure as a blueprint for speculating that certain features are inherent in Rosenbaum and then suggesting a modification of Rosenbaum based on the allegedly inherent features. As such, the rejection is improper because it is not factually supported by the evidence and is based upon impermissible hindsight.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicants' argued that it would not have been obvious to modify Rosenbaum to include the step at issue since such a modification would render Rosenbaum's system unsatisfactory for its intended purpose and/or would change the principle of operation of Rosenbaum's invention (Response dated October 5, 2007, pages 12-14). The Examiner answered:

... time comparisons are well known in the art to be contained within time-based production systems. Since Rosenbaum discloses a system which has to meet time constraints before being passed along to another part of the system, the modification would not render the prior art unsatisfactory.  
(Final Office Action, page 2).

Applicants disagree with the substance of this statement, and note that the Examiner has not identified any disclosure in Rosenbaum that teaches that the system "has to meet time constraints before being passed along to another part of the system." To the contrary, Rosenbaum only discloses that a feeding mechanism 110 pulls successive mail pieces from magazine 111 and transports the pieces to high-resolution video scanner 120 at a rate of approximately 10 mail pieces per second (col. 4, lines 21-24). The mail pieces are then sent to a delay loop 121 while the image 122 of the address is resolved. If the image 122 is recognizable by the processor, then the mail piece is taken out of the delay loop and sorted into a bin. If the image 122 is not machine-recognizable, then the mail item is left in the delay loop or taken offline while the image is forwarded to a clerk for manual video coding.

However, there is no teaching of meeting time constraints before being passed to another part of the system. To the contrary, Rosenbaum makes no mention at all of time constraints of various portions of the system. Again, the Examiner appears to be speculatively reading features into Rosenbaum without any factual support, which renders the rejection improper.

For all of the above-noted reasons, Applicants submit that Rosenbaum does not render the inventions recited in claims 1, 10, and 15 obvious. Claims 2-4, 14, and 16-19 depend from an allowable base claim and are allowable by virtue of the allowability of their respective base claims. Moreover, as discussed below, the applied art does not suggest many of the additional features of these claims.

#### Claims 5 and 20

Applicants incorporate by reference the arguments set forth at pages 15-17 of the Response dated October 5, 2007. According to those arguments, neither Rosenbaum nor Manduley teaches *the estimated time for video coding is comprised of a weighted average*

*response time, as recited in claim 5, or at least one of the at least one programmable processor determines the estimated time for video coding based on a weighted average response time, as recited in claim 20.*

The Examiner, in answering these arguments, asserts that Manduley teaches an average response time, while Rosenbaum discloses weighting. More specifically, the Examiner asserts that the priority disclosed at lines 10-20 of col. 5 constitutes weighting. The Examiner concludes that the combination, taken as a whole, teaches the limitations as claimed. Applicants disagree.

Manduley discloses a mail delivery system in which an anticipated schedule of each mail piece through the system is based upon, *inter alia*, the typical or average time it should take for processing through each station of the system. However, Manduley does not disclose average processing time of video coding. In fact, Manduley makes no mention of video coding. Moreover, Manduley only teaches an average processing time, and does not teach a weighted average time. Therefore, Manduley cannot be relied on to teach an estimated time for video coding is a weighted average response time.


The “priority” identified by the Examiner and described in Rosenbaum is based upon the expertise of each respective clerk (col. 7, lines 3-4; col. 5, lines 19-23). This “priority” is not associated with an average response time for video coding. Therefore, the priority of Rosenbaum’s clerks is wholly unrelated to the average processing time at Manduley’s stations. As such, no proper combination of the two references teaches *the estimated time for video coding is comprised of a weighted average response time, as recited in claim 5, or at least one of the at least one programmable processor determines the estimated time for video coding based on a weighted average response time, as recited in claim 20.*

### **Conclusion**

Reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested and believed to be appropriate.

February 22, 2008  
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